

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants: JENKINS et al.

Appln. No.: 09/777,979

Filed February 6, 2001

Title: MEDICAL IMPLANT FOR
ELECTRO-STIMULATION USING
DISCRETE MICRO-ELECTRODES

Group
Art Unit: 3754

Examiner: Nicolas, Frederick C.

CERTIFICATE OF MAILING

I hereby certify that this paper or fee is
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Washington, D.C. 20281, on this date.

11/6/02
Date

Registration No. 30,562
Attorney For Applicants

RESPONSE

Hon. Commissioner of Patents and Trademarks
Attention: Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This response is in regard to the Office Action dated August 8, 2002, for the
above-identified application.

Submitted Drawings Are Not New Matter. In the Office Action of August 8,
2002, the Examiner indicated that

"The filing date of this application has not been assigned due to the
dismissal of the applicant's petition (see paper #10, 6/25/2002). Since, any
subsequently filed drawings will constitute new matter, then the
examiner now withholds any action on the merits in this application"
(emphasis added).

Applicants specifically disagree with the Examiner's conclusion that submission of new drawings would "constitute new matter." First, this appears to be a conclusion without any supporting arguments or articulated basis. Nowhere has the Examiner indicated why such drawings would be "new matter" in light of the specification as specifically submitted. Nowhere has the Examiner indicated why a person of ordinary skill in the art would not understand and be able to use the invention described in the specification as originally filed. Applicants believe that the specification as originally filed complied with 35 U.S.C. §112 and that one of ordinary skill in the art would have been able to understand the invention described in the specification and would have been able to make and use the invention.

With regard to this "new matter" issue,¹ Applicants also wish to bring to the Examiner's attention the "REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR §1.182" which was filed on October 25, 2002. In this REQUEST FOR RECONSIDERATION, Applicants noted:

"In the Petition dated February 26, 2002, Applicants argued that drawings were fully described in the specification as filed and, thus, that the incorporation of the drawings would not constitute new matter. This issue was not addressed in the Decision on Petition.¹ Applicants respectfully request that the Office of Petitions address this issue.

As noted, Applicants believe that the specification as originally filed on February 6, 2001, fully enabled and provided written description of the invention in terms, and in sufficient detail, to allow one of ordinary skill in the art to fully understand and use the invention. Thus, Applicants believe that "a drawing is not necessary for the understanding of the invention but [that] the subject matter sought to be patented admits of illustration by a drawing." MPEP 608.02 (Handling of Drawing Requirements under Second Sentence of 35 U.S.C. 113). In such cases, the lack of a drawing does not render the application incomplete but rather is treated as an informality. In such cases,

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The Decision on Petition did indicate that Applicants argued that since "the drawings were in the possession of the Office at the time the subject application was filed, the drawings would not constitute new matter" (third paragraph). Applicants respectfully submit that this argument is significantly different from the argument that the specification as filed fully described the invention and the drawings, and that inclusion of the drawings would not constitute new matter.

Applicants are allowed to provide the drawings so long as they do not introduce new matter.² Id.

The present invention is fully described and enabled in the specification as originally filed. The specification (see, e.g., page 16, line 10, through page 29, line 2) clearly provides a complete and detailed description of the invention in terms that allows one of ordinary skill in the art to fully understand and use the invention. Thus, one of ordinary skill in the art would find the invention enabled without the drawings. This is especially true since, as indicated on page 27, lines 12-21, earlier patents and applications describing the basic electro-implant devices and immobilizing mechanisms are incorporated by reference in the present application. Thus, the inadvertent omission of the drawings should not render the application defective under 37 CFR §1.53. Moreover, and as indicated earlier, inclusion of the drawings as requested by the original Petition does not constitute new matter; all reference numbers and elements in the drawings as submitted with the original Petition are fully described in the specification as filed." (Footnotes in original.)

Applicants, for the reasons presented above, do not believe that submission of drawings (i.e., the drawings presented in the provisional application and fully described in the specification as originally filed) would constitute new matter. Indeed, Applicants respectfully suggest that the lack of drawings does not render the application incomplete but only informal. Applicants respectfully suggest that the Examiner, under MPEP 608.02, request that such drawings be submitted to correct this informality.

Restriction Requirement. The Examiner also issued a restriction requirement, naming two Groups as follows:

- I. Group I. Species A (Figures 1 and 2)
 - Subspecies A1 (Figure 3A)
 - Subspecies A2 (Figure 3B)
 - Subspecies A3 (Figure 4A)
 - Subspecies A4 (Figure 4B)
 - Subspecies A5 (Figure 4C)
- II. Group II. Species B (Figures 5A-5C and 6A-C).

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Since the drawings submitted with the original Petition in the present case could easily be compared with the drawings submitted with the provisional application, the determination that no new matter is being introduced can easily be confirmed.

Applicants hereby elect Group I **without traverse**. As requested by the Examiner in the event Group I (Species A) was elected, Applicants hereby elect Subspecies A1 **with traverse**. Claims 1-7 and 16-44 read on Species A. Claims 1-7 and 16-44 read on Subspecies A1 (as well as Subspecies A2, A3, A4, and A5). Claims 8-15 will be canceled without prejudice at the appropriate time during further prosecution.

As noted, the election of Subspecies A1 was, however, with traverse. With regard to Subspecies A1-A5, these subspecies differ mainly in the shape of the individual micro-electrodes. As noted in the specification, the number and shapes of the micro-electrodes can be varied as desired. Page 19, lines 24-30. None of the claims specify or limit the **shape** of the micro-electrodes. Accordingly, all of species A1, A2, A3, A4, and A5 read upon exactly the same claims (namely 1-7 and 16-44). Thus, there is no basis for this subspecies requirement since the claims do not distinguish between the subspecies provided by the Examiner. It is claims that are subject to restriction requirements, not specific embodiments described in the specification or Figures.


Applicants, therefore, request that the restriction requirement with regard to subspecies A1, A2, A3, A4, and A5 within Group I be withdrawn.

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Should the Examiner feel that a telephonic interview would assist in resolving any issue regarding this application, he is requested to contact the undersigned at the number below.

The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY



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Date: November 6, 2002

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